

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Parametric Technology Corporation,)
Opposer,)
v.)
PLMIC, LLC,)
Applicant.)

2285506
Opposition No. 91 174 641

PLMIC, LLC,)
Opposer,)
v.)
Parametric Technology Corporation,)
Applicant.)

446662367
Opposition No. 91 177 168

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July 2, 2009
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**BRIEF FOR PARAMETRIC TECHNOLOGY CORPORATION
AS DEFENDANT IN OPPOSITION NO. 91 177 168 and
REPLY BRIEF AS PLAINTIFF IN OPPOSITION NO. 91 174 641**



07-06-2009

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PARTIES' POSITIONS TO DATE

The Description of the Record, Statement of the Issues, and Recitation of the Facts have been set out by the parties in their respective initial briefs.

Parametric Technology Corporation (PTC) as plaintiff in the first opposition against the application to register FLEXPLM by PLMIC LLC (PLMIC) asserts the application is invalid because the dates of use in the PLMIC application are false and fraudulent. PTC, as defendant in the second opposition, brought by PLMIC against the application to register FLEXPLM by PTC, asserts that PLMIC does not have priority of use over PTC.

PLMIC asserts, essentially, the opposite.

PLMIC has also, as part of its response to PTC's initial brief, included a motion to amend the date of first use in PLMIC's application. PTC opposes the amendment.

ARGUMENT

A. PLMIC'S APPLICATION IS VOID AND IT MAY NOT AMEND ITS APPLICATION

(1) PLMIC's Assertions of Use in Its Application Were False and Fraudulent

The application filed by Jason Silvestri on March 13, 2006 to register FLEXPLM began with Jason Silvestri asserting a date of first use of July 13, 2003, based on when he first thought about using the mark, and a date of first use in commerce of July 20, 2004, based on when he registered a domain name. These dates were the fantasies of someone who decided to make assertions in a legally significant filing when he had no idea of the legal requirements for the filing. His attorney's defense is that Mr. Silvestri was ignorant of legal standards.

However, the trademark application system relies on the honesty and care of the trademark applicant asserting dates of first use. The Trademark Examiner has no way to review or confirm these dates when they are asserted by the applicant. Unchecked, the dates are given great credibility when a trademark registration issues, as it almost did in this case. Such recklessness should not be rewarded after it is exposed with only the paperwork of amendment.

Mr. Silvestri was aided and abetted by counsel, moreover. He was represented by counsel who entered an appearance in the trademark application two months after it was filed.

Apparently, no review of the dates of use of the pro se applicant was ever undertaken by counsel.

Then when Mr. Silvestri was represented by other counsel in the opposition proceedings, his first answer to the notice of opposition directed at his application was only to give up the first date of use of July 1, 2003 and rely on the second of July 20, 2004.

When he was presented with interrogatories and document production requests, then he gave up both dates, and moved to March 2005, a date for which the best he can say is that it is when he began making his services "available." It is this date of March, 2005 that is the date to which Mr. Silvestri currently wishes to amend his application.

It cannot be a defense to fraud to say that one made assertions in a legal document without knowing at all what the significance of those assertions might be. In Sinclair Oil Corp. v. Kendrick, 85 U.S.P.Q. 2d 1032 (T.T.A.B. 2007), the Board found fraud on the part of a pro-se applicant who had filed a use-based application based on registration of a fictitious business name, and the giving away of twenty-five product samples. The Board held that "the applicant knew or should have known such representations were false." Sinclair v. Kendrick at 1037. As a businessman claiming significant rights under the trademark law, Mr. Silvestri also should have known whether or not his assertions about use were false, particularly his original date of first use of July 13, 2003, which appears to have been a wholly made-up date.

(2) PLMIC's Assertion of A Later Date of Use Is Not Based on Law

PLMIC's motion to amend its application's date of first use to March, 2005 is a desperate act to maintain its application as a use-based application while tinkering with the date of first use. PLMIC would have us believe that some minor adjustment is all that is needed to keep its application valid. In order to do this, however, PLMIC asserts that over a half century of law interpreting the Lanham Act's requirements for a trademark application has been wrong. The rule that use of a service mark first occurs when the services are rendered in commerce is interpreted by PLMIC as just an option for defining use. PLMIC argues that instead the Lanham Act may also be satisfied by someone who is "ready, willing and able" to sell his services.

Mr. Silvestri's testimony is that in March 2005, "As a sole proprietor of Top of The Food Chain, I posted to the internet a certain availability of certain services with my FlexPLM Advertising Solutions." Silvestri Dep., p. 7-8. Later, Mr. Silvestri asserts that he made his "first sale of FlexPLM services" in September, 2006. Silvestri Dep., p. 17. Unfortunately for PLMIC's purposes, this purported "sale" in September 2006 was a half-year after the March 2006 filing date of PLMIC's trademark application. Therefor, PLMIC is reduced to arguing for March 2005 as a date of first use, since it is before the application filing date.

In order to do that, PLMIC argues that when Mr. Silvestri was "ready, willing and able" to sell his services in March 2005, it qualified as "use" under the Lanham Act. PLMIC cites no case law for this interpretation.

PLMIC asserts that a holding by the Board in In re Cedar Point, 220 U.S.P.Q. 533 (T.T.A.B. 1983) that the "actual rendering of the services in commerce" is necessary for use for registration purposes is obsolete because it was decided before the 1988 amendment to §45 of the Lanham Act. But that amendment raised the standard for use, by requiring now that the use be "the bona fide use of a mark in the ordinary course of trade, and not merely to reserve a right in the mark." It did not lower the standard from that required in Cedar Point.

PLMIC also asserts that the legislative history of the 1988 amendment to the Lanham Act supports PLMIC's theory because Congress intended "use in commerce" to be interpreted with "flexibility to encompass various genuine, but less traditional, trademark uses such as those made in test markets, infrequent sales of large or expensive items" However PLMIC was not in an industry where less traditional trademark use is the norm. PLMIC was in an industry in which you provided services or you did not, and PLMIC did not.

The recent decision by the Federal Circuit in Aycock Engineering Co. v. Airflite Inc., 90 U.S.P.Q. 2d 1301 (Fed. Cir. 2009) just reiterated this fundamental rule concerning the kind of use that is necessary for registration. In Aycock, the Federal Circuit affirmed the holding of the T.T.A.B. that a registration obtained in 1974 was insufficiently grounded in use that was merely preparatory to providing services rather than actually providing them. Although the registrant had laid the groundwork for providing services to customers, he had never actually provided the services described in the registration to anyone. The Court pointed out that its holding applied to the Lanham Act as it existed in 1970, but that it also applied to current (and post-1989) service use requirements as well. Aycock v. Airflite, at 1306.

Thus, the argument that March, 2005 qualified as a date of first use for trademark registration under the Lanham Act is absurd. PLMIC's use-based application cannot be amended because there was no use before its filing date.

B. PTC HAS PRIORITY OVER PLMIC BECAUSE PLMIC
HAS NOT DEMONSTRATED ADEQUATE USE OF ITS MARK

(1) PLMIC's Asserted Uses Are At Best Insubstantial
and At Worst Non-Existent

Against this backdrop of discussing the legal consequences of facts stated by PLMIC, it is worth pointing out that no documentary evidence corroborating any use of his mark by Mr. Silvestri actually exists. This leads to a conclusion that, regardless of the condition of the PLMIC application, PLMIC has not demonstrated any priority of use, or use analogous to trademark use, over PTC.

For example, about his March, 2005 "use," Mr. Silvestri says that "As a sole proprietor of Top of The Food Chain, I posted to the internet a certain availability to certain services with my FlexPLM Advertising Solutions." Silvestri Dep., p. 7-8. When asked what those "FlexPLM Advertising Services" entailed, Mr. Silvestri said (referring to the description of services in the trademark application) "I would have to say the goods and services description here would best describe it." Silvestri Dep., p.-13-14. When asked about whether he had any records of the advertising of the services, Mr. Silvestri said, "I did, but I can't retrieve that. That was a couple years ago, the computer crashed. I tried desperately to revive them. I could not do so." Silvestri Dep., p. 14.

We have no idea what Mr. Silvestri "posted" to the internet. We have no idea for what periods of time anything he posted to the internet was available. We have no idea whether anyone accessed or viewed what he posted. It is not clear what Mr. Silvestri's anticipated services were. He "described" them in his trademark application but there is no assurance that he was any more accurate about that description than he was about his date of first use. The PLMIC brief goes too far in asserting that by March, 2005, "Silvestri had posted the mark FLEXPLM on the Internet as an advertisement of already-available services," or that "PLMIC's FLEXPLM advertising occurred on the Internet, which is worldwide and continuous." We simply do not know what Mr. Silvestri did on March, 2005 because we only have his description to go on, without any corroborating documentary evidence. The testimony of his brother-in-law, Mr. Noseworthy, is only that Mr. Silvestri described his FLEXPLM advertising services but then the discussion shifted to web design services after Mr. Silvestri showed him a website that impressed Mr. Noseworthy with Mr. Silvestri's website design skills.

The next date of significance is Mr. Silvestri's asserted first sale of his services in September, 2006. There are two things worth noting about this date. One is that it is a year-and-a-half after the "posting" to the internet. Clearly, this is an indication of the minimal impact, if any, that Mr. Silvestri was having on the public. The second is that it is again not clear what services Mr. Silvestri "sold" then. He says that he "created a proposal which entailed various ways to manifest their interfacing on their websites." Silvestri Dep., p. 29. He called this "development" (p. 29), which is different from advertising services. Frankly, it appears that once again Mr. Silvestri was hired for his website design skills, and not to provide whatever he thought his FLEXPLM services were.

PTC, on the other hand, consistently and continuously used its mark in connection with its services starting in May, 2005. Nothing Mr. Silvestri did before then was open, public or notorious use of his mark.

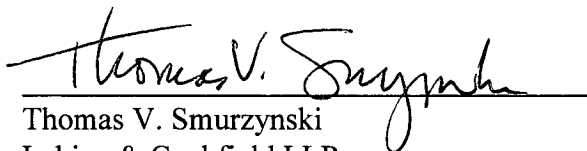
SUMMARY

Mr. Silvestri was an IT consultant, making his website design skills available to others. He filed a trademark application for a business he hoped to start, in which he put down first use dates willy-nilly without any concern about whether they were legally justified or not. He and his lawyers asserted these dates until calls for evidence forced their retraction.

An amendment of the date of first use for the PLMIC application is now proposed that has no legal basis. The amendment should be refused, and the application should be held invalid as a use-based application filed before use had begun. If necessary the application should be held invalid on the basis of fraud. PTC's opposition should be upheld.

The use claimed by PLMIC is insufficient and unsubstantiated and does not give it priority over PTC's regular, commercial use. PLMIC's opposition to PTC's application should be dismissed.

Respectfully Submitted,
Parametric Technology Corporation
By its attorneys,

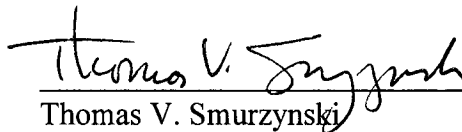


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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **BRIEF FOR PARAMETRIC TECHNOLOGY CORPORATION AS DEFENDANT IN OPPOSITION NO. 91 177 168 and REPLY BRIEF AS PLAINTIFF IN OPPOSITION NO. 91 174 641** was served by first-class mail, postage prepaid, on counsel for Applicant, Edward A. Haffer, Sheehan Phinney Bass & Green, P.A., 1000 Elm Street, P.O. Box 3701, Manchester, NH 03105-3701, on this 2nd day of July, 2009.


Thomas V. Smurzynski